

REMARKS

Claims 1, 3, 6, and 12-20 are pending with claims 4 and 8-11 canceled by this paper. Applicants acknowledge Examiner Tran's time and courtesy extended to Applicant's representative James E. Ruland during the personal interview of 19 May 2004. See Interview Summary. No exhibit was shown or demonstration conducted, U.S. Patent Nos. 6,136,500 (Kobayashi) and 5,695,906 (Nishi), and the Seimi Chemical Co., Ltd. (product literature), and claims 1, 6 and 10 were discussed. The only claim amendment discussed was correcting a typographical error in the term "naphthoquinonediazide" as incorporated above in claim 20. This correction does not narrow the scope of the claim. Below is a summary of the arguments presented at the interview.

Arguments

Double Patenting

Claim 11 has been canceled removing this objection.

Claim Rejections Under 35 U.S.C §103

Claims 1, 3, 6, 12-16 and 19 stand rejected as allegedly being unpatentable over Kobayashi and the product literature. Applicants respectfully traverse these rejections.

At the outset, Applicants would like to incorporate by reference the remarks made in the Reply mailed 21 August 2003, at pages 7-8. With respect to the allegation in the Action that one of ordinary skill in the art would be motivated to use KH-40TM surfactant because of its lower flammability, Applicants respectfully submit that there is no motivation for one of skill in the art to include a low flammable surfactant in the resist composition of Kobayashi. Particularly, Kobayashi at columns 22-23 discloses that the resist composition is combined with a solvent so that the total solids in the preparation are 5-50% by weight. See column 22, lines 38-44. Specific solvents are disclosed at column 22, line 45 to column 23, line 13. Most, if not all of these solvents, are organic solvents. Consequently, many of these solvents would be flammable.

As such, the low flammability of the surfactant would be of little importance because the surfactant is included in a resist composition combined with a flammable organic solvent. Consequently, Applicants respectfully submit that low flammability would provide insufficient motivation for one of skill in the art to combine these references. Consequently, Applicants respectfully submit that a *prima facie* case of obviousness is lacking.

Moreover, the present invention provides significant and unexpected results. Particularly, Table 8 of the present specification at page 12 discloses resist compositions of the present invention including surfactants such as KH-40 surfactant as sample #5. All of these compositions provide an initial particle number less than 5 and a storage stability greater than 120 days. In marked contrast, comparison compositions provided in Table 9 include surfactants, such as a 381 surfactant as sample #6, which is also disclosed in the product literature. As depicted, compositions made with the surfactant #6 have a storage stability of 90 days and an initial particle number ranging from 13-26. See Table 9 at page 13 of the present specification. This data demonstrates the significant and unexpected results of the resist compositions of the present invention incorporating the claimed surfactant. Consequently, Applicants respectfully submit the Examiner has sufficient legal authority to withdraw these rejections.

Claim 10 stands rejected as allegedly being unpatentable over Kobayashi in view of Nishi and claims 11 and 20 stand rejected as allegedly being unpatentable over Kobayashi and Nishi in view of the product literature. Applicants note that claims 10 and 11 have been canceled, and claim 20 has been re-written into independent form. As discussed above, Applicants respectfully submit that there is insufficient motivation to combine these references, and moreover, the present invention provides significant and unexpected results. Consequently, Applicants respectfully submit that claim 20 should be indicated as allowed.

With respect to claim 17-18, these claims are patentable over the cited art including U.S. Patent No. 5,849,808 (Schacht), at least due to their dependency, although further arguments may be made to distinguish claims 17-18 from Schacht.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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